

Serial No. 10/670,502

Attorney Docket No. 26A-010

**REMARKS**

Please note that a form PTO-1449 was filed on 21 November 2006. The applicants respectfully request an initialed copy of the form PTO-1449 filed on 21 November 2006.

Claims 21-23 and 25-34 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 21-23 and 26-31 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,628,944, Nagasaka et al. ("Nagasaka"). Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 21 recites in combination, for example, "forming a releasing agent layer, the releasing agent layer being composed of a releasing agent, adhered to a wall surface of a cavity of a mold that is in a closed state by injecting a first liquid containing the releasing agent and a solvent into the closed cavity and depressurizing the closed cavity to a pressure at which the solvent boils ..." Independent claim 29 recites in combination, for example, "injecting a first liquid including a releasing agent and a solvent that vaporizes under a reduced pressure into the closed cavity; forming a releasing agent layer composed of the releasing agent adhered to the entire surface of the closed cavity by depressurizing the closed cavity to a pressure at which the solvent vaporizes ..."

The office action asserts that Nagasaka anticipates the invention as claimed. To the contrary, Nagasaka fails to set forth each and every element found in the claims as amended. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical

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invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Nagasaka fails to teach or suggest the combination of features recited in independent claims 21 and 29. For example, Nagasaka fails to teach or suggest forming a releasing agent layer, which is composed of a releasing agent, adhered to a wall surface of a cavity of a mold that is in a closed state by injecting a first liquid containing the releasing agent and a solvent into the closed cavity, and depressurizing the closed cavity to a pressure at which the solvent boils. (See, e.g., claims 21, 29.) To the contrary, Nagasaka discloses applying a mold release agent to a surface of an opened cavity. (Col. 7, lines 18-20 "Open the mold 1 and apply a mold release agent to the cavity surface ...".) According to Nagasaka, a mold releasing layer is formed by direct application of the mold release agent to the opened cavity.

Furthermore, Nagasaka fails to teach or suggest depressurizing of the closed cavity. To the contrary, Nagasaka teaches forming the mold releasing layer on the opened cavity, and accordingly fails to teach or even suggest depressurizing a closed cavity to form the releasing agent layer.

It is noted that Nagasaka discusses "filling the cavity of a mold under vacuum with a small amount of a surface forming RIM polyurethane material for subsequent molding by RIM", where an auxiliary component may be a mold release agent (Col. 1, lines 57-66.) However, the surface layer formed by the surface forming RIM material is not a releasing layer composed of a releasing agent. Rather, Nagasaka's object for such surface layer is for "molding multi-property polyurethane parts by RIM, such as, two-color parts having an interior layer covered with a thin

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surface layer." (Col. 1, lines 41-54.) Therefore, Nagasaka fails to teach or suggest forming the releasing agent layer as recited.

Nagasaka fails to teach or suggest, for example, these elements recited in independent claims 21 and 29. The other references of record fail to remedy these deficiencies of Nagasaka. It is respectfully submitted therefore that claims 21 and 29 are patentable over Nagasaka.

For at least these reasons, the combination of features recited in independent claims 21 and 29, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Nagasaka clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 21 and 29, but also because of additional features they recite in combination.

Claim 25 was rejected under 35 USC 103(a) as being unpatentable over Nagasaka in view of U.S. Patent No. 3,768,232, Farber ("Farber"). The applicants respectfully request that this rejection be withdrawn for reasons including the dependency of claim 25 from independent claim 21, which is deemed to be allowable for reasons discussed above.

New claims 32-35 have been added to further define the invention, and are believed to be patentable for reasons including these set out above. Support for new claims 32, 33 and 35 is located in the original application, for example, page 10, lines 5-24. New claim 34 is analogous to claim 21.

New claim 32, 33 and 35 are deemed to be allowable not only due to their dependency from claims 21, 29 and 34, but also because of additional features in combination. Claim 32 recites in combination "placing an insert member in the mold prior to said forming of the releasing agent layer; and closing the mold prior to said forming of the releasing agent layer."

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Claim 33 recites in combination "placing an insert member in the mold prior to both of said closing the mold and said injecting the first liquid." Claim 35 recites "placing an insert member in the mold; and thereafter closing the mold, wherein said placing an insert member and said closing the mold are performed prior to said injecting the first liquid," where the first liquid is "composed of a releasing agent and a solvent" (claim 34).

Nagasaka fails to teach or suggest placing an insert member in a mold prior to forming a releasing agent layer, as further recited in claims 32, 33 or 35. To the contrary, Nagasaka's sequence of steps is to "(1) Open the mold and apply a mold release agent to the cavity surface ... (2) Set the core 46 of a steering wheel 45 in the lower mold 3; then close the mold 1 to form the cavity ..." (Col. 7, lines 18-23.) That is, Nagasaka discloses placing a core after forming a releasing agent layer in an opened cavity.

Accordingly, for these additional reasons, it is respectfully submitted that claims 32, 33 and 35 are patentable over the references.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

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In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

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